

## REMARKS

### Claims Status

Applicants acknowledge the indication that dependent claims 3, 6 and 9 contain allowable subject matter. Claims 1-9 are pending. Claims 1-9 have been amended. New claims 10 and 11 have been added. No new matter has been added by way of this amendment. Reconsideration of the application is respectfully requested.

### Objection to the Title

The Examiner has objected to the title of the invention as being nondescriptive. Applicants have amended the title in a suitable manner.

### Rejection of claims under 35 U.S.C. §102

Claims 1 and 2 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2003/0099007 (“*Towner*”). Applicants have carefully considered the Examiner's rejection, and the comments provided in support thereof, and respectfully disagree with the Examiner's analysis. For the reasons which follow, it is respectfully submitted that all claims of the present application distinguish the invention patentably over the cited reference.

The present invention relates to an image forming apparatus having a fixing device that pressurizes and heats an unfixed toner image on a paper sheet, i.e., a transfer medium, to fix the image on the paper sheet. The image forming apparatus of claim 1 includes a glossiness changing device and a controller for changing the output order of fixed images prior to printing out the images. The claimed apparatus makes it possible to rearrange the printing order of the fixed images in order to shorten the time required to switch between glossiness requirements. As

a result, printing efficiency is greatly improved. See pages 12-14 referring to Fig. 7, and particularly the bottom of page 13.

*Towner* relates to user selectable gloss levels and user selectable placement of gloss areas within a page produced by a hard copy output engine (see para [0001]). According to *Towner*, the method includes “providing a user with a user-adjustable control for varying hard copy output gloss and varying at least one processing parameter in producing the hard copy output” (see para [0011]). However, *Towner* fails to disclose the invention recited in claim 1. In particular, *Towner* fails to disclose “a controller to change an output order of fixed images to be printed out based on glossiness set by said glossiness changing device,” as recited in amended independent claim 1. Consequently, claim 1 is patentable over *Towner* and, thus, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 are in order, and a notice to that effect is earnestly solicited.

### **Rejection of claims under 35 US.C. §103**

Claims 4, 5, 7 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Towner* in view of U.S. Patent No. 6,522,843 (“*Yamada*”). For the reasons which follow, it is respectfully submitted that all claims of the present application distinguish the invention patentably over these applied references.

Independent Claims 4 and 7 include the feature of "a controller to change an output order of fixed images to be printed out based on the thickness of the paper sheet" (quote taken from claim 4, with somewhat different wording being used in claim 7). *Towner* clearly does not include this feature.

*Yamada* relates to an image forming apparatus, such as a printer, a copying machine, a

facsimile machine and a multi function printer, in which a toner image is formed on an intermediate transfer member, and then transferred to a recording medium, such as paper or an OHP film sheet (i.e., a film sheet for an overhead projector) (see col. 1, lines 13-19).

The Examiner contends the following:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image forming apparatus disclosed by Towner et al. with a thickness detection means and a fixing condition changing means as taught by Yamada et al, for the purpose of providing images of good development.

With respect to the foregoing statement, Applicants respectfully assert that *Yamada* fails to cure the deficiencies of *Towner*. Specifically, *Yamada* fails to disclose, teach or suggest “a controller to change an output order of fixed images to be printed out based on the thickness of the paper sheet,” as recited in independent claim 4, nor does *Yamada* teach “a controller to change an output order of fixed images to be printed out based on... the thickness of the paper sheet,” as recited in amended independent claim 7. Thus, even a combination of these two references does not provide the claimed invention. Consequently, independent claims 4 and 7 are patentable over the combination of *Towner* and *Yamada*. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. §103 are in order, and a notice to that effect is earnestly solicited.

By the foregoing amendments, claim 3, 6 and 9 have been placed into independent form. Since claims 3, 6 and 9 were indicated to contain allowable subject matter, as noted previously, Applicants submit that claims 3, 6 and 9 are now in condition for formal allowance.

In view of the patentability of independent claims 1, 3, 4, 6, 7 and 9 for the reasons set forth above, dependent claims 2, 5, 8, as well as new dependent claims 10 and 11 are also patentable over the cited prior art.

### Conclusion

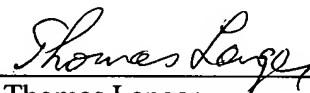
Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

Please charge the amount of \$600 in payment for the addition of three (3) new independent claims in excess of three to our Patent and Trademark Office Deposit Account No. 03-2412.. Any additional fees or charges required at this time in connection with the present application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By   
Thomas Langer  
Reg. No. 27,264  
551 Fifth Avenue, Suite 1210  
New York, New York 10176  
(212) 687-2770

Dated: February 17, 2005